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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,322	12/29/2000	Rob Sullivan	10559/197001/P8369	9163
20985	7590	07/01/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER	SMITH, SHEILA B
			ART UNIT	PAPER NUMBER
			2681	8

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/751,322	SULLIVAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sheila B. Smith	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 March 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 18-22 is/are allowed.
- 6) Claim(s) 1-17 and 23-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-~~17~~, 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Partos et al. (U. S. Patent Publication 2002/0023006).

*Regarding claims 1 - 4*, Partos et al. discloses essentially all the claimed invention as set fourth in the instant application, further Partos et al. discloses system and method of electronic commerce. In addition Partos et al. discloses a method comprising: receiving an electronic order from a first party (which reads on “a means to receive customer information and order information from a customer's terminal” page 2 paragraph [0011]); receiving information about the first party (which reads on “the customer has to disclose his or her name, address or other personal information to the seller for transaction” page 1 paragraph 0004); a transmitting the order to a second party; transmitting less information about the first party to the second party than was received (which reads on a means to input customer information and order information that serves to specify a transaction item or transaction items page 2 paragraph 0011); and transmitting a voucher to the second party (which reads on “transmitting means 12 to transmit confirmation information to the customer's terminal” page 2 paragraph 0043).

***Regarding claims 2,8*** Additionally Partos et al. discloses transmitting no information about the first party to the second party (which reads on a means to input customer information and order information that serves to specify a transaction item or transaction items page 2 paragraph 0011).

***Regarding claims 3, 9*** Additionally Partos et al. discloses 3. The method of claim 1, further comprising transmitting selected information about the first party to the second party, wherein transmission of the selected information is authorized by the first party (which reads on page 1 paragraph 0004).

***Regarding claims 4, 10*** Additionally Partos et al. discloses comprising retrieving information from a database concerning the first party, and selecting information about the first party for transmission to the second party based on the retrieved information (which reads on page 1 paragraph 0004).

***Regarding claims 5,11*** Additionally Partos et al. discloses retrieving records from a database concerning the first party comprises retrieving directives describing the information to be withheld from the second party (which reads on page 1 paragraph 0004).

***Regarding claims 6, 12*** Additionally Partos et al. discloses receiving information about the first party comprises receiving information about the first party from a subscriber identity module (which reads on page 1 paragraph 0004).

***Regarding claims 7,*** Partos et al. discloses essentially all the claimed invention as set fourth in the instant application, in addition Partos et al. discloses a article comprising a computer-readable medium which stores computer-executable instructions for receiving and transmitting information (which reads on “the term "electronic commerce" mentioned in this specification means a commercial transaction conducted through an electronic network by using an information processing device, such as a personal computer, a server, a cellular phone” page 1 paragraph 0002), the instructions causing a machine to, receiving an electronic order from a first party (which reads on “a means to receive customer information and order information from a customer's terminal” page 2 paragraph [0011]); receiving information about the first party (which reads on “the customer has to disclose his or her name, address or other personal information to the seller for transaction” page 1 paragraph 0004); a transmitting the order to a second party; transmitting less information about the first party to the second party than was received (which reads on a means to input customer information and order information that serves to specify a transaction item or transaction items page 2 paragraph 0011); and transmitting a voucher to the second party (which reads on “transmitting means 12 to transmit confirmation information to the customer's terminal” page 2 paragraph 0043)

***Regarding claims 13-17,*** Partos et al. discloses essentially all the claimed invention as set fourth in the instant application, in addition Partos et al. discloses a system comprising: a processor and a database, wherein the processor is configured to receive information about a first party (which reads on “information processing apparatuses, such as computers or servers, and includes a database management means 11, a transmitting means 12, a receiving means 13”

disclosed on page 2 paragraph 00026), wherein the processor is configured to receive an electronic transactional order from the first party, wherein the processor transmits the order to a second party (which reads on “its principal function is to convey an order or a request for service from a customer to a seller or convey a seller's response to a request for service or other information to a customer” disclosed on page 2 paragraph 00026), and wherein the database includes information about the first party and directives describing the information about the first party to be transmitted to the second party (which reads on page 2 paragraph 0011).

***Regarding claims 23-25***, Partos et al. discloses essentially all the claimed invention as set fourth in the instant application, in addition Partos et al. discloses a method comprising: placing an electronic order with a second party on behalf of a first party (which reads on page 2 paragraph [0011]; and providing information about the first party to the second party (which reads on page 2 paragraph 0011); wherein the amount of information provided is a function of consideration from the second party (which reads on a means to input customer information and order information that serves to specify a transaction item or transaction items page 2 paragraph 0011).

***Regarding claims 26 - 28***, Partos et al. discloses essentially all the claimed invention as set fourth in the instant application, in addition Partos et al. an article comprising a computer-readable medium which stores computer-executable instructions for receiving and transmitting information (which reads on “the term "electronic commerce" mentioned in this specification means a commercial transaction conducted through an electronic network by using an information processing device, such as a personal computer, a server, a cellular phone” page 1

paragraph 0002), the instructions causing a machine to placing an electronic order with a second party on behalf of a first party (which reads on page 2 paragraph [0011]; and providing information about the first party to the second party (which reads on page 2 paragraph 0011); wherein the amount of information provided is a function of consideration from the second party (which reads on a means to input customer information and order information that serves to specify a transaction item or transaction items page 2 paragraph 0011)

***Allowable Subject Matter***

2. Claims 18-22 are allowed.

***Claim 18*** is allowed. The following is an examiner's statement of reasons for allowance: The prior art of record considered alone or in combination neither anticipates nor renders obvious a first party interface coupled to the network; a second party interface coupled to the network; and s an anonymizer, comprising a processor, a database and a communication interface, the anonymizer coupled to the network by the communication interface, a wherein the anonymizer receives information about a first party, the anonymizer receives an electronic order placed on the network through the first party interface, in the anonymizer is configured to transmit the order to the second party interface, and the anonymizer is configured to transmit less information about the first party to the second party interface than was received.

The prior art of record provided numerous teachings of e-commerce. However, the prior art of record failed to specifically disclose the anonymizer receives an electronic order placed on the network through the first party interface, in the anonymizer is configured to

transmit the order to the second party interface, and the anonymizer is configured to transmit less information about the first party to the second party interface than was received.

***Response to Amendment***

3. The declaration filed on 3/23/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Partos et al. reference.
4. The Partos et al. reference is a U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the patent may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.
5. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Partos et al. reference. 37 USC 1.131 (b) states The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Art Unit: 2681

6. Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. In re Carlson, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (703)305-0104. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S. Smith *S.S.*  
June 28, 2004

*Erika Gary*  
ERIKA GARY  
PATENT PRACTICER